UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09,765,835	01/19/2001	Stuart Cheshire	04860.P2596	9901

7590	06/25/2004

Tom Van Zandt
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER
PATEL, NIKETA I

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/765,835	CHESHIRE, STUART
	Examiner	Art Unit
	Niketa I. Patel	2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 October 2003</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-43</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-43</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>14 May 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 7

DETAILED ACTION

Specification

1.   The disclosure is objected to because it contains an

embedded hyperlink and/or other form of browser-executable code.

Applicant is required to delete the embedded hyperlink and/or

other form of browser-executable code. See MPEP § 608.01.

Drawings

2.   Figure 4A should be designated by a legend such as --Prior

Art-- because only that which is old is illustrated. See MPEP

§ 608.02(g). Corrected drawing sheets are required in reply to

the Office action to avoid abandonment of the application. The

replacement sheet(s) should be labeled "Replacement Sheet" in

the page header (as per 37 CFR 1.84(c)) so as not to obstruct

any portion of the drawing figures. If the changes are not

accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office

action. The objection to the drawings will not be held in

abeyance.

Claim Objections

3.   Claims 33 and 39 are objected to because of the following

informalities: lines 1 and 2 recite, 'network configuration

information has added *to it* said presentation information'

however it should recite, 'network configuration information has

added said presentation information'. Appropriate correction is

required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs

of 35 U.S.C. 102 that form the basis for the rejections under

this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-3, 5-12, 14-21 and 23-43 are rejected under 35

U.S.C. 102(e) as being anticipated by Krishan et al. U.S. Patent

Number: 6,442,529 (hereinafter referred to as "*Krishan*".)

6.   **Referring to claims 1, 10 19,** *Krishan* teaches a method, a

device and a machine readable medium that provides executable

instructions, implemented on a processing system, comprising:

receiving a request for network configuration information from a

client processing system [see column 12 - lines 18-30, 41-52];

sending network configuration information from a server

processing system to the client processing system, the network

configuration information having added to it, at least one of presentation information, or an address representative of said presentation information such that said presentation information is presented when the client processing system uses the network configuration information [see column 12 - lines 41-52, 'configuration information, such as a uniform resource locator (URL) of the advertisement server from which mini-portal will receive pointers to advertisements'.]

7.   **Referring to claims 2, 11, 20,** *Krishan* teaches wherein the network configuration information is network initialization and wherein said presentation information is determined at least in part by said network configuration information [see column 12 - lines 18-30, 'mini-portal displays advertisements and other messages only at times...such as when personal computer is connecting to the Internet' and column 5 - lines 29-47.]

8.   **Referring to claims 3, 12, 21,** *Krishan* teaches wherein the network configuration information is formatted in accordance with a configuration protocol [see column 21 - lines 47-55.]

9.   **Referring to claims 5, 14, 23,** *Krishan* teaches wherein the presentation information causes text to be presented [see column 11 - lines 20-25, column 12 - lines 53-65 and column 14 - liens 7-23.]

10. **Referring to claims 6, 15, 24,** wherein the address

representative of the presentation information includes a URL

command [see column 11 - lines 20-25, column 12 - lines 53-65

and column 14 - liens 7-23.]

11. **Referring to claims 7, 16, 25,** *Krishan* teaches wherein the

URL command reference a web page [see column 11 - lines 20-25,

column 12 - lines 53-65 and column 14 - liens 7-23.]

12. **Referring to claims 8, 17, 26,** *Krishan* teaches wherein the

web page contains commercial information [see column 11 - lines

20-25, column 12 - lines 53-65 and column 14 - liens 7-23.]

13. **Referring to claims 9, 18, 27,** *Krishan* teaches a method, a

device and a machine readable medium that provides executable

instructions, implemented on a processing system, comprising:

requesting network configuration information from a server

processing system [see column 12 - lines 18-30, 41-52];

receiving network configuration information at a client

processing system, the network configuration information having

added to it at least one of presentation information or an

address representative of said presentation information such

that said presentation information is presented when the client

processing system uses the network configuration information

[see column 12 - lines 41-52, 'configuration information, such

as a uniform resource locator (URL) of the advertisement server

from which mini-portal will receive pointers to

advertisements'.]

14. **Referring to claim 28,** *Krishan* teaches automatically

presenting said presentation information on the client

processing system [see column 11 - lines 20-25, column 12 -

lines 18-30, 41-52 and column 14 - liens 7-23.]

15. **Referring to claim 29, 35, 40, 41, 42,** wherein said

presentation information is automatically presented upon network

initialization without any input action from a user or the

client processing system [see column 11 - lines 20-25, column 12

- lines 18-30, 41-52 and column 14 - liens 7-23.]

16. **Referring to claims 30, 36,** *Krishan* teaches wherein said

network initialization is not in response to a user input to

access a web page [see column 11 - lines 20-25, column 12 -

lines 18-30, 41-52 and column 14 - liens 7-23.]

17. **Referring to claims 31, 37,** *Krishan* teaches wherein said

network initialization is not in response to a user input

instructing an application program to access network [see column

11 - lines 20-25, column 12 - lines 18-30, 41-52 and column 14 -

liens 7-23.]

18. **Referring to claims 32, 38,** *Krishan* teaches wherein said

network initialization is preformed without a pending

application request for network access [see column 11 - lines

20-25, column 12 - lines 18-30, 41-52 and column 14 - liens 7-

23.]

19.   **Referring to claims 33, 39,** *Krishan* teaches wherein the

network configuration information has added *to it* said

presentation information [see column 11 - lines 20-25, column 12

- lines 18-30, 41-52 and column 14 - liens 7-23.]

20.   **Referring to claims 34, 43,** *Krishan* teaches wherein said

presentation information is automatically presented on the

client processing system upon network initialization using the

network configuration information [see column 11 - lines 20-25,

column 12 - lines 18-30, 41-52 and column 14 - liens 7-23.]

Claim Rejections - 35 USC § 103

21.   The following is a quotation of 35 U.S.C. 103(a) which

forms the basis for all obviousness rejections set forth in this

Office action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains.· Patentability shall not be
> negatived by the manner in which the invention was made.

22.   Claims 4, 13 and 22 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Krishan et al. U.S. Patent Number:

6,442,529 (hereinafter referred to as "*Krishan*".)

23. **Referring to claims 4, 13, 22,** *Krishan* teaches wherein the network configuration information is formatted in accordance with a configuration protocol [see column 21 - lines 47-55] however does not set forth the limitation wherein the configuration protocol is the Dynamic Host Configuration Protocol.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to get the advantage of allowing a server to dynamically assign IP addresses to nodes on the fly by using DHCP. Also, like it's predecessor DHCP supports manual, automatic and dynamic address assignment. It would have been obvious to one or ordinary skill in the art at the time of applicant's invention to use Dynamic Host Configuration Protocol to get this advantage.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents have been made record of to further show the state of the art as it pertains to providing users with advertisements upon network initialization:

Iannucci et al. U.S. Patent Number: 6,219,698
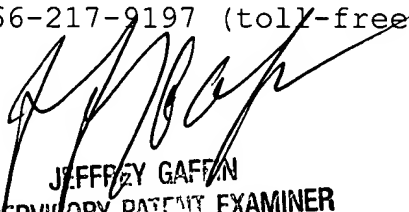
Kubik et al. U.S. Patent Number: 6,611,915

Lim et al. U.S. Patent Number: 6,732,181

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niketa I. Patel whose telephone number is (703) 305 4893. The examiner can normally be reached on M-F 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (703) 308 3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

NP
06/22/2004